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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,844	07/03/2001	Edward T. Hessel	K-4	1464
27123	7590	05/23/2006	EXAMINER	
MORGAN & FINNEGAN, L.L.P.			SINGH, PREM C	
3 WORLD FINANCIAL CENTER				
NEW YORK, NY 10281-2101			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/898,844

Applicant(s)

HESSELL ET AL.

Examiner

Prem C. Singh

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,5,16,18,20,22,24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5,16,18,20,22,24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 3, 5, 16, 18, 20, 22, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostusyk et al. (US 4,880,553) in view of Xiao et al (US 5,993,644).

The Kostusyk reference discloses a composition that comprises an oil of lubricating viscosity as well as a pour point depressant composition. The pour point depressant composition can be an alkylated naphthalene that contains more than one alkyl chain. The alkyl chains may be derived from olefins having 8 to 30 carbon atoms and include olefins as in claims 22, 24, 26, and 27. The amount of the pour point depressant added to the lubricating oil composition can be up to 50% by weight. The lubricating oil composition may also contain other additives such as detergents. See column 2, lines 1 1-44; column 4, lines 3-25 and 41-64; and column 6, lines 29-48.

The Kostusyk reference does not disclose that the oil of lubricating viscosity is a Group III base oil.

Xiao discloses that, "According to API publication 1509, a Group III base stock contains greater than or equal to 90% saturates and less than or equal to 0.03 %sulfur and has a viscosity index greater than or equal to 120." (Column 2, lines 26-35). "In the present process, a high quality oil, such as a Group II or a Group III oil, is produced." (Column 2, lines 62-64).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Kostusyk and Xiao and use a Group III base oil in the composition because such base oils are high quality lubricating oils.

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Therefore, one would expect to produce an effective lubricating oil composition by using a Group III base oil in the composition of Kostusyk because Kostusyk suggests that any lubricating oil can obtain a beneficial pour point depressing effect when mixed with the disclosed alkylated naphthalenes.

### ***Response to Arguments***

The applicant's argument mentions that in Kostusyk invention the pour point reduction can only be obtained by linking aromatic groups together with methylene bridges (-CH<sub>2</sub>-).

The Applicant's argument is not persuasive since Kostusyk clearly discloses the use of alkylated naphthalenes (Column 5, lines 1-4).

The Applicant's argument mentions that Kostusyk invention uses only 0.05 to 2% of the concentrate as compared to the Applicant's use of 10 to 50% of the alkylated naphthalene.

The Applicant's argument is not persuasive because Kostusyk invention discloses that the PPD (pour point depressant) may be present up to 50% by weight. (Column 6, lines 41-44).

In response to the Applicant's argument of not using Group III base oil teaching from the prior art, a new reference (Xiao et al, US Patent 5,993,644) has been provided.

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Applicant's argument regarding Kostusyk's use of alkylated naphthalenes with different structure is not persuasive because Kostusyk invention does provide the option of using alkylated naphthalenes as claimed by the applicant (Column 4, lines 3-14).

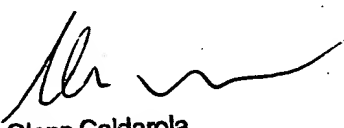
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prem C. Singh whose telephone number is 571-272-6381. The examiner can normally be reached on MF 6:30 AM-3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ps/050406

  
Glenn Caldarola  
Supervisory Patent Examiner  
Technology Center 1700